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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/156,952	09/18/1998	ROY A. OSTGAARD	11.009011 US	1770

41696 7590 09/23/2010

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ART UNIT	PAPER NUMBER
1797	

MAIL DATE	DELIVERY MODE
09/23/2010	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROY A. OSTGAARD, EDWARD J. O'CONNELL,
and MARK J. LICARI

Appeal 2010-001956
Application 09/156,952
Technology Center 1700

Before TERRY J. OWENS, PETER F. KRATZ, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-8, 10, and 12-26.[1] We have jurisdiction under 35 U.S.C. § 6(b).

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[1] No rejection of claim 27, which is the only other pending claim, is before us. The rejection of claim 27 in the final rejection (mailed Jan. 1, 2005, p. 3) is not maintained in the Examiner's Answer (Ans. 3, 5).

The Invention

The Appellants claim a sample vial. Claim 1 is illustrative:

1. A sample vial for use in an automated test apparatus, the sample vial comprising:

a body comprising an outer surface, an open end, a closed end, and at lease one anti-rotation lug about said body outer surface, the anti-rotation lug comprising a generally flat, lower-most surface extending radially outwardly from said body outer surface along a plane perpendicular to said body outer surface, the lowermost surface located closer to the open end than to the closed end;

a cap releasably engagable with said body, said cap comprising an outer surface and a torque pattern on said cap outer surface, said torque pattern comprising a plurality of radially disposed ribs; and

a seal disposed between said body and said cap so as to be capable of forming a substantially fluid-tight seal therebetween,

wherein the lower-most surface is accessible when the cap is engaged with the body for reacting against proximate structure of the automated test apparatus when installed therein to facilitate at least one of automated removal and installation of the cap.

The References

Moore	5,855,289	Jan. 5, 1999 (filed Apr. 25, 1997)
Brodner	5,894,733	Apr. 20, 1999 (filed Jan. 7, 1998)

The Rejection

Claims 1-8, 10, and 12-26 stand rejected under 35 U.S.C. § 103 over Brodner in view of Moore.

OPINION

We affirm the rejection for the reasons given in the Opinion in the Board's previous Decision in this case (mailed Oct. 22, 2003), which we incorporate herein, and the reasons which follow.

Issue

Have the Appellants indicated reversible error in the Examiner's determination that Brodner would have rendered prima facie obvious, to one of ordinary skill in the art, an anti-rotation lug comprising a generally flat lowermost surface extending radially outwardly from a sample vial body outer surface along a plane perpendicular to the body outer surface?

Findings of Fact

The findings of fact are set forth in the Board's previous Opinion (pp. 3-5).

Analysis

Claim 1 is the sole independent claim in both the previous appeal and this appeal. In the previous appeal claim 1 required "an anti-rotation lug comprising a generally flat, longitudinally disposed surface extending radially outwardly from said body outer surface, the longitudinally disposed surface comprising a lowermost edge that is substantially perpendicular to said body outer surface". In the present appeal claim 1 requires "an anti-rotation lug comprising a generally flat, lower-most surface extending radially outwardly from said body outer surface along a plane perpendicular to said body outer surface".

The Appellants argue that "even assuming that Brodner and Moore can be combined, there is a significant element not disclosed in the resulting vial – i.e., a lug having a generally flat, lower-most surface that extends

radially outwardly from the outer body surface of the vial along a plane perpendicular to the body outer surface" (Br. 5).

"[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1256 (Fed. Cir. 2007), quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). For written descriptive support for the claim limitation "a generally flat, lower-most surface extending radially outwardly from said body outer surface along a plane perpendicular to said body outer surface" the Appellants rely solely upon their Figure 5 (Br. 4). The Appellants present a blowup of that figure with a horizontal line, which represents a plane, drawn through the bottom of the lug (18) perpendicular to the vial body (12) outer surface (Br. 6; Reply Br. 1-2). A blowup of the Appellants' Figure 5 without the horizontal line, however, shows that the bottom of the lug (18) is curved, first downwardly away from the vial body (12) outer surface and then upwardly. Hence, the broadest reasonable interpretation of the Appellants' claim limitation "a generally flat, lower-most surface extending radially outwardly from said body outer surface along a plane perpendicular to said body outer surface" in view of the Appellants' disclosure includes some deviation of the plane from perpendicularity.

The Appellants argue that the ridges on the left side of Brodner's Figure 4 are tapered (Reply Br. 10-11). The Appellants present a blowup of Brodner's Figure 2 which shows a lug having a tapered lower surface (Br. 8).

The ridges in Brodner's figures appear to have been drawn in by hand. Most appear tapered but in Figure 4 the lower right edge of the left lug

appears to be flat and the lower left edge of the right lug appears to be nearly flat. As pointed out in the previous Board Opinion (p. 5) Brodner does not disclose that the lower edges of the ridges are tapered or indicate that they should be tapered. Brodner would have led one of ordinary skill in the art, through no more than ordinary creativity, to configure the lower edges of the ridges as they are illustrated in the reference, i.e., tapered, nearly flat or flat. *See KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (In making an obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ"). The flat or nearly flat lower edges of the ridges would fall within the Appellants' claim limitation "a generally flat, lower-most surface extending radially outwardly from said body outer surface along a plane perpendicular to said body outer surface" as construed above.

Nor does the Appellants' Specification indicate that the lower surfaces of the lugs should be flat. The Appellants' Specification states that "other suitable materials, dimensions, and configurations for the body, the cap, the ribs, the lugs, the fluid level indicia, and other features of the sample vial will be apparent to those skilled in the art, those disclosed being provided as examples only" (Spec. 14:14-16). The disclosure that the lug can have other configurations does not support the Appellants' argument that there is criticality to the lower surface of the lug (18) in the Appellants' Figure 5 being flat, i.e., that the flat lower surface ensures that the vial (10) will not penetrate too deeply into the bores (52, 62), thereby causing the vial (10) to jam, or axially translate to an improper position when in the vial sleeve (64) (Reply Br. 5). That argument also is not supported by the remainder of the

Appellants' Specification and appears to be applicable also to lugs having lower surfaces that are somewhat tapered.

The Appellants argue that the lower surfaces of Brodner's sleeve ridges (56) must be tapered to prevent them from abutting against the uppermost surfaces of the tray ridges (68) when attempting to slide the sleeve structure (12) into the aperture (62) of the tray (16) (Reply Br. 8-12). The Appellants argue that axial alignment between Brodner's sleeve ridges (56) and tray ridges (68) naturally occurs as the beveled edges of the sleeve ridges (56) slide against the beveled uppermost surfaces of the tray ridges (68) (Reply Br. 12-13).[2]

Brodner teaches that the ridges (56) of the sleeve structure (12) are placed into pressing engagement against or between the ridges (68) in the tray (16)'s apertures (62) (col. 3, ll. 37-41). For the sleeve structure (12)'s ridges to be placed in pressing engagement between the ridges (68) in the tray (16)'s apertures (62) each sleeve structure (12)'s ridge must be aligned with a space between the ridges (68) in the tray (16)'s apertures (62), regardless of whether the lower surfaces of the sleeve structure (12)'s ridges are flat or tapered. Brodner does not indicate that such alignment requires tapered ridges and the Appellants have provided no evidence that tapered ridges would be required.[3]

The Appellants state that they do not understand the statement in the previous Board Opinion (p. 6) that if anything, Brodner's teaching that the

[2] The Appellants do not point out where Brodner discloses that the uppermost surfaces of the tray ridges (68) are beveled.
[3] The Appellants have merely provided unsupported attorney argument that flat lower ridge surfaces would make alignment more difficult (Reply Br. 11-12).

ridges produce a locking type action (col. 3, ll. 38-40) would have led one of ordinary skill in the art to make the edges of the ridges perpendicular to the outer surfaces of the sleeve and tray to maximize the locking action (Reply Br. 13). The Appellants argue that it is the longitudinal surfaces of the ridges, not the edges that provide the locking action. *See id.*

The possible increased locking action provided by ridges that are rectangular rather than having tapered ends would be due to the slightly increased ridge surface area provided by the rectangular shape.

Conclusion of Law

The Appellants have not indicated reversible error in the Examiner's determination that Brodner would have rendered prima facie obvious, to one of ordinary skill in the art, an anti-rotation lug comprising a generally flat lowermost surface extending radially outwardly from a sample vial body outer surface along a plane perpendicular to the body outer surface.

DECISION/ORDER

The rejection of claims 1-8, 10, and 12-26 under 35 U.S.C. § 103 over Brodner in view of Moore is affirmed.

It is ordered that the Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

sld

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